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EXAMINER

GILLIGAN, CHRISTOPHER L

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3626

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/579,407
Filing Date: May 25, 2000
Appellant(s): BATES ET AL.

Peter C. Stomma
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/19/06 appealing from the Office action mailed 7/15/05.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,537,315	MITCHAM	7-1996
5,239,462	JONES et al.	8-1993

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11, 13-18, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462.

As per claim 1, Mitcham teaches a method of generating an insurance quote for an individual, comprising the steps of: obtaining data from an applicant for insurance (see column 5, lines 12-28); automatically underwriting an insurance risk for an item using the data obtained from the applicant (see column 6, lines 4-10); and generating and providing an insurance quote to the applicant wherein the insurance quote is for the provision of insurance to cover the item (see column 6, lines 10-25).

Mitcham does not explicitly teach determining the acceptability of a loan, obtaining data from a lender's database and using the data to underwrite a corresponding insurance risk, and advising the applicant of the acceptability of the loan contemporaneously with providing the insurance quote. Jones teaches a method for determining the approval status of a potential borrower (see column 3, lines 23-31); and further utilizing the method to provide data regarding the potential borrower to an insurance provider to permit follow-up with the potential borrower (see column 3, lines 23-31 and column 7, lines 31-45). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting

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insurance providers and lenders for the purpose of further decreasing the amount of time needed to purchase and insure a vehicle by a potential customer (see column 4, lines 17-24).

As per claim 3, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the insurance quote is provided by an insurance provider (see column 6, lines 1-4).

As per claim 4, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the step of underwriting the insurance risk includes the additional steps of: providing a plurality of insurance companies for underwriting the insurance risk (see column 5, lines 58-65); and determining a set of terms for each of the plurality of insurance companies for which each of the plurality of insurance companies will accept the insurance risk (see column 5, line 66 – column 6, line 4).

As per claim 5, Mitcham in view of Jones teach the method of claim 4 as described above. Mitcham further teaches the additional step of selecting one of the sets of terms and providing the insurance quote in response thereto (see column 6, lines 15-19).

As per claim 6, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant (see column 6, lines 39-45).

As per claim 7, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the additional steps: storing the data after providing the insurance quote (see column 8, lines 38-41); and providing an additional insurance quote in response to a request by the applicant (see column 8, lines 55-59).

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As per claim 8, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the step of requesting permission from the applicant prior to obtaining data from additional sources (see column 43-58).

As per claim 9, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches a second portion of the data is obtained from a third party (see column 7, lines 55-61).

Claims 11, 13-18, 20, and 22-23 contain substantially similar limitations to claims 1 and 3-9 and, as such, are rejected for similar reasons as given above.

Claims 2, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462 and further in view of Danilunas et al., U.S. Patent no. 6,263,320.

As per claim 2, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham does not explicitly teach providing the insurance quote by the lender. Danilunas teaches a method for utilizing a financial product for the financing of an automobile purchase and further providing automobile insurance to the potential purchaser of the automobile (see column 5, lines 5-24). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting insurance providers and lenders for the purpose of enabling the selling of such insurance services at a discounted rate (see column 5, lines 5-7 of Danilunas).

Claims 12 and 21 contain substantially similar additional limitations to claim 2 and, as such, are rejected for similar reasons as given above.

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Claims 10, 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462 and further in view of Dugas, **Not the total solution Bankruptcy stays on credit reports.**

As per claim 10, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham does not explicitly teach that the third party is a credit bureau. Dugas discloses third party reporting of information for an application for insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of obtaining data in the system of Mitcham from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to perform such a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

Claims 19 and 24 contain substantially similar additional limitations to claim 10 and, as such, are rejected for similar reasons as given above.

(10) Response to Argument

In the Appeal Brief filed 19 January 2006, Appellant makes the following arguments:

A) Neither of the cited references teaches a method of generating an insurance quote wherein the insurance quote is provided to the applicant contemporaneously with a favorable decision on a loan application.

B) Neither of the cited references teaches a method for generating an insurance quote that utilizes data obtained from a lender's database.

C) The claims do not require the applicant to apply for or request a quote for insurance.

D) Jones does not teach any action other than the referral of the potential borrower to the insurance companies.

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Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Argument A:

In response to Appellants' first argument, the Examiner acknowledges that this feature is taught by the combined teachings of Mitcham and Jones, whereby Mitcham teaches providing an insurance quote and Jones teaches advising the applicant of the acceptability of the loan. However, Jones teaches that upon notifying the potential borrower of the acceptability of the loan, the data regarding the borrower is provided to insurance companies for "immediate follow-up" (see column 7, lines 31-45 of Jones). Therefore, it is respectfully submitted that an insurance quote generated by an insurance company that has immediately followed-up with an applicant is a form of the recited limitation of providing an insurance quote contemporaneously with a favorable decision on a loan application.

Response to Argument B:

In response to Appellants' second argument, it is first noted by the Examiner that the claims merely recite that the data obtained from the lender's database is utilized to generate an insurance quote. As noted above, such data is clearly utilized in the system of Jones to permit immediate follow-up by insurance companies with a potential borrower. Furthermore, Mitcham describes a system in which an applicant and insurance companies, who are already in contact, interact to communicate an insurance quote to the applicant. It is respectfully submitted that the combination of Mitcham and Jones teaches a system in which data obtained from a lender's database is utilized to generate an insurance quote by putting insurance companies in contact with potential borrowers (column 7, lines 31-45 of Jones) who can then generate an insurance

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quote (column 6, lines 10-25 of Mitcham). Since the claims do not exclude any additional data being provided from an applicant to an insurance company, it is respectfully submitted that the combination of Mitcham and Jones teaches this limitation.

Response to Argument C:

In response to Appellants' third argument, the Examiner respectfully submits that each of the independent claims recite the transitional term "comprising." Therefore, the scope of the claims is only limited to include at least those steps recited. Accordingly, the fact that a user can apply for insurance in Mitcham is not excluded from claimed limitations.

In addition, Appellants assert that the recited insurance quote is generated utilizing the data obtained from the lender's database and not from an application for insurance. As noted above, the referral of a name to insurance companies, when combined with Mitcham, involves utilization of data to ultimately generate an insurance quote. Furthermore, the claims do not exclude also utilizing data from an application for insurance. Therefore, it is respectfully submitted that although both Jones and Mitcham teach additional steps that are not recited in the claims, such additional steps are not excluded from the claims.

Response to Argument D:

In response to Appellants' fourth argument, the Examiner respectfully disagrees and submits that Jones describes referral of the potential borrower to the insurance companies for "immediate follow-up" with the potential borrower (see column 7, lines 43-45 of Jones). It appears the Appellant disregards this action of immediate follow-up with the potential borrower. However, such a teaching in Jones is critical to the combination of Jones and Mitcham. It is respectfully submitted that one of ordinary skill in the art of loan and insurance processing would

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recognize that immediate follow-up by an insurance company with a potential borrower would be for the purpose of providing relevant insurance information, such as insurance quotes or underwriting an insurance policy, to the borrower. Therefore, it is respectfully maintained that the combination of Mitcham and Jones teaches the claimed invention, given the level knowledge available to one of ordinary skill in the art at the time of the invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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